

REMARKS

Reconsideration and withdrawal of the rejection of claims 7-9 and 19-21 is respectfully requested in view of the following remarks.

The Examiner rejected claims 7-8 and 19-21 under 35 U.S.C. § 103(a) as obvious over German Patent No. DE 3800482 to List ("*List*") in view of U.S. Patent No. 5,374,270 to McGuire ("*McGuire*"). The Examiner asserted that *List* teaches all of the claimed limitations except "a bore that may fit a guide wire" and "a pair or multiple elongated slots." The Examiner further asserted that *McGuire* teaches a bore that may fit a guide wire and that including a pair or multiple elongated slots is mere duplication of the essential working parts.

Applicants respectfully submit that the Examiner has not established prima facie obviousness of the invention as claimed in the last response. The Examiner is required to show, among other things, that the prior art references teach or suggest all of the claim limitations. In addition, the Examiner must show that there is a motivation or suggestion to combine the references. Because the Examiner has failed to show these things, Applicants respectfully traverse the Examiner's rejections.

First, the Examiner has not shown that all the claim limitations have been taught or suggested by the prior art. For example, neither *List* nor *McGuire*, alone or in combination, teach a window that provides a view of the trailing end of a guide wire as required by independent claims 7 and 19. *McGuire* teaches a bore where "the guide pin protrudes about 10 mm from the shank end of the drill bit," thereby leaving an exposed portion that can be manipulated by a user during extraction of the drill bit. See *McGuire*, col.4 ll.40-44. Therefore, even if the guide wire of *McGuire* were viewable through a window in the drilling instrument, the trailing end would clearly not be

visible through the window. *List* discloses no guide wire at all.

Second, there is no suggestion or motivation to combine the *List* and *McGuire* references because the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose." See MPEP 2143.01. Claims 7 and 19 require a "drive end having an open therethrough in communication with said bore for viewing said guide wire trailing end" and "a guide wire . . . having a trailing end viewable through the windows in the shank."

*List* discloses a cutting element surrounded by a sleeve, where the cutting element has depth gauge markers thereon and the sleeve has a window that provides visual access to the depth gauge markers. See *List*, abstract and FIG. 2. If the bore of *McGuire* were combined with the drilling instrument of *List*, with the windows providing a view of the guide wire as required by claims 7 and 19, then the depth gauge markers would no longer be viewable through the window. The result would be that the drilling instrument of *List* would be rendered unsatisfactory for its intended purpose.

Thus, even if the drill tool 1 of *List* were cannulated, a "second" window would have to be provided in the marked area of the drill shaft. The only way to see any part of the k-wire would be to align the "second" window with the "first" window of the sleeve 5. If this were done then the marks would not be visible, thereby defeating the purpose of *List*.

In Applicants design, the k-wire end is always visible regardless of the position of the drill shaft with respect to the sleeve.

Applicants further submit that claims 8-9 and 20-21, which depend from claims 7 and 19, constitute allowable subject matter at least by virtue of being dependent upon allowable

independent claims. Therefore, in light of the foregoing, Applicants respectfully request allowance of claims 7-9 and 19-21. Alternatively, Applicants request that the Examiner enter this response in the record for purposes of appeal.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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